

### **REMARKS**

This preliminary amendment is filed responsive to the final rejection mailed 30 November 2004 and the Advisory Action mailed 11 May 2005.

Please note the filing of new powers of attorney in the case. Please conduct future correspondence with the undersigned attorney.

#### **Specification amendments and new matter**

The amendments to the specification made above are responsive to the Examiner's requirement, as the prior addition of the specific language now deleted was determined to constitute new matter.

However, the applicants respectfully direct the Examiner's attention to claim 6 as originally filed on 25 February 2002. Incorporation of that claim language into the specification at page 5, second full paragraph, and page 7, first full paragraph, does not constitute new matter.

#### **Claim status**

Claims 1, 3, 4, 6, 12, 14 and 29 are pending, all other claims having been cancelled, either previously or with this response.

Claim 29 is a new independent claim, but does not require any fee for excess claims.

#### **Claim rejection – 35 USC §112**

The applicants respectfully traverse the Examiner's holding that claim 6 is not enabled by the specification under 35 USC 112, second paragraph. The present amendments to the specification at page 5, second full paragraph, and page 7, first full paragraph, provide the necessary enablement. Support for the amendments is provided above in the section entitled "Specification amendments and new matter."

#### **Double patenting**

The double patenting rejection based previously upon US Pat. 6,656,181 is believed to be overcome by the filing of a terminal disclaimer.

#### **The Rejection under 35 U.S.C. §102(b)**

In the Office Action to which this response is directed, the Examiner has made a final rejection of all pending claims as anticipated by US Pat. 4,488,543 to Tornier ("Tornier '543"). The applicants have previously presented arguments as to why Tornier '543 does not anticipate the claims. Those arguments are incorporated by reference.

More importantly, new claim 29 is directed at clearly distinguishing Tornier '543, which fails to teach or even suggest an interference fit of a portion of an unthreaded shank portion of the screw into the underlying bone structures that are being stabilized by the device. The Examiner has stated that Fig. 3 of Tornier '543 shows a portion of a tapered head extending beyond the bottom surface of the plate, so that it would inherently extend into the bone in an interference fit. The Examiner also states that the tapered head would inherently make an interference fit with the tapered hole. The applicants respectfully disagree with both of these statements.

First, and as now required by claim 29, the disclosure describes the fit between the unthreaded shank portion and the tapered hole as being self-locking. See, for example, the second full paragraph of page 3 or the second full paragraph of page 5. If the screws of Tornier '543 were self-locking, there would be no need for Tornier '543's elastic disk 11 and screw 9. Further, Tornier describes the fit between the screw head and the tapered hole as being "complementarily configured" rather than self-locking.

Second, a major portion of the previously-unsolved problem being addressed by the present invention is the embedding of the threaded shank portion into the bone, to reduce the potential for screw breakage just below the point of attachment to the plate, as pointed out at page 3, first paragraph. The screw of Tornier '543 is subject to this breakage, precisely because a portion of the head extends below the surface of the plate. The Tornier '543 screw has no unthreaded shank portion.

### Conclusion

In view of the foregoing amendment and accompanying remarks, the applicant respectfully submits that the present application is properly in condition for allowance. Telephone inquiry to the undersigned in order to clarify or otherwise expedite prosecution of the subject application is respectfully encouraged.

Respectfully submitted,

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